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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,163	07/12/2004	Walter Keller	3002	5205

7590
Striker Striker & Stenby
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02/08/2007

EXAMINER

AHMED, HASAN SYED

ART UNIT

PAPER NUMBER

1615

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	10/501,163		KELLER ET AL.	
	Examiner		Art Unit	
	Hasan S. Ahmed		1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of applicants' response to the restriction requirement, which was filed on 16 November 2006.

* * * * *

Election/Restrictions

Applicants' election with traverse of Group I in the reply filed on 16 November 2006 is acknowledged. The traversal is on the ground(s) that the Gumprecht et al. reference does not teach that zein itself is useful for inclusion in cosmetic compositions that treat hair. This is not found persuasive because the reference teaches the common technical feature of all instant claim groups, i.e. use of zein in the treatment of hair (see col. 4, line 57). The fact that the reference teaches the possibility of combining zein with other compounds does not negate this teaching

The requirement is still deemed proper and is therefore made FINAL.

Claims 14-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 16 November 2006.

* * * * *

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for natural zein alone in improving the condition of hair. Based on the instant disclosure, it is the examiner's position that applicants do not describe this invention in such a manner that would enable one of ordinary skill in the art to practice this invention without undue burden. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Enablement is considered in view of the Wands factors (MPEP 2164.01 (a)). These include: (1) breadth of the claims; (2) nature of the invention; (3) state of the prior art; (4) amount of direction provided by the inventor; (5) the level of predictability in the art; (6) the existence of working examples; (7) quantity of experimentation needed to make or use the invention based on the content of the disclosure; and (8) relative skill in the art. All of the factors have been considered with regard to the claim, with the most relevant factors discussed below:

The breadth of claims: Instant claim 1 is directed to improving the condition of hair with natural zein alone. It is the examiner's position that this claim is not supported by the instant specification.

The nature of the invention: The instant invention is directed to natural zein.

The state of the prior art: Morawsky et al. (U.S. Patent No. 5,518,717) disclose natural zein as a component of a composition that results in improving the condition of hair. Applicants have claimed that natural zein alone will improve the condition of hair

(see claim 1), however, the application does not disclose how natural zein alone can improve the condition of hair.

The amount of direction provided by the inventor: There is nothing in the specification that would indicate that natural zein alone can result in improvement of the condition of hair. As a result, one of ordinary skill in the art would have to revert to trial and error experimentation in order to practice the invention commensurate in scope with the instant claim set.

The presence or absence of working examples: There are no examples in the instant specification showing the improvement of the condition of hair using natural zein alone.

The quantity of experimentation: In order to utilize the invention as claimed, the skilled artisan would be presented with an unpredictable amount of experimentation. The instant disclosure does show how to practice instant claim 1. Thus the disclosure is not commensurate in scope with the claims.

The relative skill of those in the art: the skill of one of ordinary skill in the art is very high, e.g., Ph.D. and M.D. level technology.

*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it is unclear what exactly the applicants are

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referring to in the following recitation: "...exposure of the hair to chemical and/or physical noxae." Clarification is requested.

*

Claims 10-13 recite the limitation "agent". There is insufficient antecedent basis for this limitation in the claims because claim 1 (from which claims 10-13 depend) does not recite this limitation.

*

Claims 1-13 provide for the use of natural zein, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

* * *

Claim Rejections – 35 USC § 101

Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. V. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

* * *

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Morawsky et al. (U.S. Patent No. 5,518,717).

The Morawsky et al. reference discloses use of natural zein for improving the condition of hair (see col. 1, lines 8-13). The reference discloses the solution of instant claim 12 (see example 4).

No patentable weight is given to the future intended use recited in instant claims 2-9.

* * *

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morawsky et al. (U.S. Patent No. 5,518,717).

The Morawsky et al. reference discloses use of natural zein for improving the condition of hair (see above).

Morawsky et al. explain that natural zein is beneficial in cosmetic compositions because it is soluble and/or dispersible in alcohol-water solvent systems and possesses good film forming properties (see col. 2, lines 55-58).

While Morawsky et al. do not explicitly teach the ranges of instant claims 10, 11, and 13, it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine suitable percentages through routine or manipulative experimentation to obtain the best possible results, as these are variable parameters attainable within the art.

Moreover, generally, differences in concentration and temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456; 105 USPQ 233, 235 (CCPA 1955). Applicants have not demonstrated any unexpected or unusual results, which accrue from the instant ranges.


It would have been obvious to a person of ordinary skill in the art at the time the invention was made to disclose use of natural zein for improving the condition of hair, as taught by Morawsky, et al. One of ordinary skill in the art at the time the invention was made would have been motivated to make such a composition because it is soluble and/or dispersible in alcohol-water solvent systems and possesses good film forming properties, as explained by Morawsky, et. al.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hasan S. Ahmed whose telephone number is 571-272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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